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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,719	03/27/2001	Rangachari Anand	YOR920000177US1	1335

7590

01/06/2006

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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,719

Applicant(s)

ANAND ET AL.

Examiner

Matthew S. Gart

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005 and 17 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-16 is/are pending in the application.
- 4a) Of the above claim(s) 1, 3-10, 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11 and 15-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History Summary

Claims 1, 3-10 and 12-13 were withdrawn from further consideration in the instant application.

Claim 2 was previously canceled in the instant application.

Claims 14-16 were previously added in the instant application.

Claims 1 and 3-16 are currently pending in the instant application.

Claims 11, 15 and 16 are currently rejected in the instant application.

Election/Restrictions

Claims 1, 3-10 and 12-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 17th, 2005.

The traversal is on the ground(s) that no undue burden exists on examining the groups together because the groups are classified in the same class and subclass. This is not found persuasive because the groups were shown to be distinct for the reasons given in the Restriction Requirement mailed on November 10th, 2005 and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by DeFrancesco (Patent Application Publication No. 2003/0101133).

The Examiner notes, the specification as originally filed neither redefines the term “State Machine,” nor sets forth an uncommon definition so as to put one reasonable skilled in the art on notice that the applicant intended to so redefine the term “State Machine.” Limitations appearing in the specification but not recited in the claims are not read into the claims. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364,1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily).

The term “State Machine” in the claims is to be defined by using its common meaning as understood by a person of experience in the field of the invention.

Whatis.com defines a “State Machine” as any device that stores the status of something at a given time and can operate on input to change the status and/or cause an action or output to take place for any given change. *Whatis.com* further states that a computer is

basically a state machine. For the purpose of examination, a "State Machine" will be given its broadest reasonable interpretation (i.e. a computer) in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

Referring to claim 11. DeFrancesco discloses a system for executing a business process represented as a state machine running on a computing system (DeFrancesco: paragraph 0110), where transitions of the state machine represent roles of participants in the business process and actions that can be taken as part of the business process, and states of the state machine represent stages in the business process where the business process is waiting for an event to occur (DeFrancesco: at least paragraph 0058 and 0059), the system comprising:

- A computer code representation of a state machine representing a business process to be implemented (DeFrancesco: at least paragraph 0110);
- A graphical user interface (GUI) used to view and edit a graphical representation of the state machine representing the business process (DeFrancesco: at least paragraph 0038), wherein business processes can be created and modified by changing, adding, and/or removing states and transitions from the state machine representation of the business processes using the GUI and once the graphical representation is modified, a newly depicted state machine code representation is generated by computer software (DeFrancesco: at least paragraph 0092);

- A commerce flow engine which stores and executes the state machine representation of the process, including management of process user inputs, wherein when newly created or modified process is compiled, a resulting state machine is loaded for storage in state machine storage and wherein when a user works on a business process, a state machine is retrieved from said state machine storage (DeFrancesco: at least Abstract, "Workflow Management System"), and
- A client on which end user may interact with the system, actions requested by end users being passed to the commerce flow engine which processes client inputs and provides output to the client (DeFrancesco: at least paragraph 0038).

Referring to claim 15. DeFrancesco further discloses a system wherein the particular state machine retrieved from state machine storage depends on the business process, an identity of the client, and other variable criteria, the commerce flow engine including a storage of a current state of a process instance and processing of client inputs depending on the current state of the process instance and a role of the action requester (DeFrancesco: at least paragraph 0061).

Referring to claim 16. DeFrancesco further discloses a system wherein end users interact with the system by means of a web browser operating on the client (DeFrancesco: at least paragraph 0034).

Response to Amendment

Applicant's amendment filed 4/11/2005 have been entered.

Response to Arguments

Applicant's arguments filed 4/11/2005 have been fully considered but they are not persuasive.

The Examiner notes, the specification as originally filed neither redefines the term "State Machine," nor sets forth an uncommon definition so as to put one reasonable skilled in the art on notice that the applicant intended to so redefine the term "State Machine." Limitations appearing in the specification but not recited in the claims are not read into the claims. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily).

The term "State Machine" in the claims is to be defined by using its common meaning as understood by a person of experience in the field of the invention. *Whatis.com* defines a "State Machine" as any device that stores the status of something at a given time and can operate on input to change the status and/or cause an action or output to take place for any given change. *Whatis.com* further states that a computer is basically a state machine. For the purpose of examination, a "State Machine" will be given is broadest reasonable interpretation (i.e. a computer) in light of the supporting

Art Unit: 3625

disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-273-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MSG
Patent Examiner
December 10, 2005